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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,783	11/28/2001	Francois Girard	P21643	8368

7055 7590 08/28/2003

GREENBLUM & BERNSTEIN, P.L.C.  
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RESTON, VA 20191

EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/994,783

Applicant(s)

GIRARD ET AL.

Examiner

Anthony D Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 8-10, 12, 13, 18, 19, 25-30, 32, 33 and 36-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11, 14-17, 20-24, 31, 34, 35 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. With respect to the claims associated with Invention I, claim 18 will not be examined, as it should have been grouped with Invention II since it depends from claim 12 grouped with Invention II.

2. Applicant's election with traverse of Invention I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Invention II is only represented by dependent claims that only provide for the attachment of the sole claimed in claim 1 to a sports apparatus. Applicant also argues that the search for the limitations in the claims of Invention II would overlap with or be the same as that for invention I and therefore would not be burdensome on the examiner to search both Invention I and Invention II. Applicant further argues that the invention of Invention II as compared with that of invention I would be  $AB_{sp}/B_{sp}$  where  $B_{sp}$  is represented by claim 1. This is not found persuasive because, even though part of the search would be in the same class, class 36, there are other limitations of Invention II that would require the examiner to search elsewhere, thereby creating a burdensome search for the examiner in that the search for one invention would not be required for the other invention. As noted in the requirement for

Art Unit: 3728

restriction, Invention I and Invention II are related as subcombinations disclosed as useable together and have separate utility as disclosed in the requirement for restriction.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 8-10, 12, 13, 18, 19, 25-30, 32, 33, 36,37 and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

#### ***Specification***

4. The disclosure is objected to because of the following informalities: on page 17 paragraph [0077], lines 4-5, reference number 8a was defined as "guiding and/or for connecting" then later was referred to as "resisting pad" on page 17, paragraph [0078], line 8. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3728

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 contains the phrase "at the rear of the so-called metatarsophalangeal bending zone" which renders the claim so. It is not clear where this zone would be located with respect to the shoe or the shoe sole since different sized feet located within the shoe would fall on a different place on the sole. Claim 5 contains the phrase "the junction/overlapping zone" in line 1 of the claim that renders the claim vague and indefinite. There is insufficient antecedent basis for this limitation in the claim. Claim 7 contains the phrase "substantially to at least 60%, preferably at least 70% and even more preferably at least 80% of the length of the sole" which renders the claim vague and indefinite. This phrase is what is considered a "range within a range" limitation, which makes it unclear as to what range the applicant is intending to claim.

*Claim Rejections - 35 USC § 102*

Art Unit: 3728

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2, 5-7, 11, 14-17, 20-24, 31, 34, 35 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by the Great Britain references to Sportartlkekefabrik Karl Uhl GmbH GB 2,256,784 (GB '784). GB '784 discloses all the limitations of the claims including the following: a front portion 71a and a rear portion 71b more rigid in longitudinal bending than the front portion (page 12, line 19-page 13, line 10); at least one reinforcement in said two portions 63; the front portion comprises a front half-sole 71a affixed to the reinforcement 63; the rear portion comprises a rear half-sole 71b affixed to the reinforcement 63; the front and rear half-soles are assembled to one another in a junction zone 72 by cementing or riveting or welding; the limit between the flexible front portion and the rigid rear portion is located substantially at the rear of the metatarsophalangeal bending zone (See Figure 2); the junction zone is located in and/or behind the so-called metatarsophalangeal bending zone (see Figure 2); wherein a

Art Unit: 3728

reinforcement member has at least one laminated plate 72 extending from the junction zone on both the front and rear half-soles; the reinforcement member has a length at least 60% of the length of the sole (see Figure 2); the reinforcement member is assembled to the front and rear portion of the sole by cementing; the reinforcement member is made of a composite (thermoplastic material); the reinforcement member has a sandwich structure (from side-to-side rather than top to bottom); the sandwich structure has a thickness less than 3 mm (see Figures 2-6); the reinforcement member is a plate covered with at least one compatibility layer (thin layer of rubber, see 73 in Figure 4) made by of at least one synthetic film; in the rear portion the reinforcement member has one or several upward extensions 65 and is associated with at least one other reinforcement; the rear portion forms an integral assembly with a stiffener (63) covering the heel; the rear portion having a different rigidity than the stiffener (different material); the portions are made of different materials; the sole is an outer sole see Figures); the sole having at least one recess (that through 65) that shows a portion of the reinforcement; the shoe is a sports boot (see page 12, line 19); the sports boot is adapted to be affixed on a sports apparatus (spikes); the sole

Art Unit: 3728

having a plate 63 to reinforce the sole and corresponding to a planar projection of a human foot (see Figure 1).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2,256,784 as applied to claim 1 above in view of Montgomery et al. 4,924,606. GB '784 discloses all the limitations substantially as claimed except for the front and rear portions overlapping in the junction zone. Montgomery et al. '606 teaches that a two part sole can overlap each other when connected together to allow for increasing flexibility of the shoe in this region as well as allow for adaptability to many different sizes. Therefore, it would have been obvious, in view of Montgomery et al. '606, to make the front and rear portions of the sole of GB '784 overlap in the junction zone to



Art Unit: 3728

allow for better flexibility of the sole and adjustability of the sole to shoes of different sizes.

### *Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the

Art Unit: 3728

organization where this application or proceeding is assigned is  
(703) 872-9306.

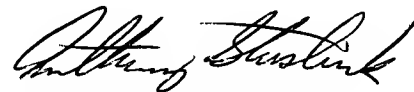
Any inquiry of a general nature or relating to the status  
of this application or proceeding should be directed to the  
receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
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Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
August 25, 2003